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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/492,697	01/27/2000	Bernard Dujon	3495.0111-11	1254

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EXAMINER

KAUSHAL, SUMESH

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 04/14/2003

24

Please find below and/or attached an Office communication concerning this application or proceeding.

SM

Office Action Summary

Application No.

09/492,697

Applicant(s)

DUJON ET AL.

Examiner

Sumesh Kaushal Ph.D.

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 61-79 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 61-79 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01/27/00 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner. *See PTO 948 P. No 4.*
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Applicant's response filed on 03/13/03 has been acknowledged. The finality of the last Office action has been withdrawn in view of new grounds of rejection below.

Claims 61-79 are pending and are examined in this office action.

► *Applicants are advised to follow Amendment Practice under revised 37 CFR §1.121 (<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>). Each amendment document that includes a change to an existing claim, or submission of a new claim, **must include a complete listing of all claims** in the application. After each claim number, the status must be indicated in a parenthetical expression, and the text of each claim under examination (with markings to show current changes) must be presented. The listing will serve to replace all prior versions of the claims in the application.*

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 61-79 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The scope of invention as claimed encompasses a recombinant mammalian chromosome comprising a Group I intron encoded endonuclease recognition site selected from group consisting of an I-SceIV site, ICsmI site, I-PanI site, I-SceII site, I-CeuI site, I-PpoI site, I-SceIII site, I-CreI site, I-TevI site, I-TevII site, I-TevIII site and I-SceI site. At best the instant specification only disclosed nucleic acid sequences of SEQ ID NO: 17, 19, 21, 23, 25, 27, 29, 35, 37, 39 41 and 43 which are cleaved by I-SceI, I-SceIV, I-SceII, I-CeuI, I-PpoI, I-SceIII, I-CreI, I-CsmI, I-PanI, I-TevI, I-Tev-II and I-TevIII endonucleases respectively.

Applicant is referred to the Interim guidelines on *Written Description* published December 21, 1999 in the Federal Register, Vol. 64, No. 244, pp. 71427-71440. The disclosure of a single species is rarely, if ever, sufficient to describe a broad genus, particularly when the specification fails to describe the features of that genus, even in passing. (see *In re Shokal* 113USPQ283(CCPA1957); *Purdue Pharma L. P. vs Faulding Inc.* 56 USPQ2nd 1481 (CAFC 2000). In the instant case the specification only teaches SEQ ID NO: 17, 19, 21, 23, 25, 27, 29, 35, 37, 39 41 and 43, which are recognition sites for I-SceI, I-SceIV, I-SceII, I-CeuI, I-PpoI, I-SceIII, I-CreI, I-CsmI, I-PanI, I-TevI, I-Tev-II and I-TevIII endonuclease. Besides the nucleotides sequences of SEQ ID NO: 17, 19, 21, 23, 25, 27, 29, 35, 37, 39, 41 and 43 the specification fails to disclose any other nucleic acid sequences that can be cleaved with I-SceI, I-SceIV, I-SceII, I-CeuI, I-PpoI, I-SceIII, I-CreI, I-CsmI, I-PanI, I-TevI, I-Tev-II and I-TevIII endonucleases explicitly or implicitly as putatively claimed by the applicant.

The possession may be shown by actual reduction to practice, clear depiction of the invention in a detailed drawing, or by describing the invention with sufficient relevant identifying characteristics (as it relates to the claimed invention as a whole) such that a person skilled in the art would recognize that the inventor had possession of the claimed invention. *See, e.g., Pfaff v. Wells Electronics, Inc.*, 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998); *Eli Lilly*, 119 F.3d at 1568, 43 USPQ2d at 1406; *Amgen, Inc. v. Chugai Pharmaceutical*, 927 F.2d 1200, 1206, 18 USPQ2d 1016, 1021 (Fed. Cir. 1991). In claims to genetic material, generic statement such as "vertebrate insulin cDNA" or mammalian insulin cDNA," without more, is not adequate written description of claimed genus, since it does not distinguish genus from others except by function, and does not specifically define any of genes that fall within its definition, or describe structural features commonly possessed by members of genus that distinguish them from others; accordingly, naming type of material generally known to exist, in absence of knowledge as to what that material consists of, is not description of that material (*Eli Lilly*, 119 F.3d at 1568, 43 USPQ2d at 1406).

In the instant case the group I intron encoded endonuclease recognition sites has been defined only by a statement of an endonuclease activity, which conveyed no distinguishing information about the identity of the claimed DNA sequence, such as its relevant structural or physical characteristics. The nucleic acid as claimed encompasses any and all variant of

endonuclease sites to be discovered by the applicant. These variants also encompass conserved nucleotide sequences, which are considered germane to the endonuclease mediated cleavage specificity. At best the specification only disclosed the nucleotide sequences of SEQ ID NO: 17, 19, 21, 23, 25, 27, 29, 35, 37, 39, 41 and 43, however the specification fails to disclose any other nucleic acid sequences that can be cleaved by I-SceI, I-SceIV, I-SceII, I-CeuI, I-PpoI, I-SceIII, I-CreI, I-CsmI, I-PanI, I-TevI, I-Tev-II and I-TevIII endonucleases explicitly or implicitly. According to these facts, one skill in the art would conclude that applicant was not in the possession of the claimed genus because a description of only one member of this genus is not representative of the variants of genus and is insufficient to support the claim.

2. Claims 61-79 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a recombinant mammalian chromosome comprising an exogenous nucleic acid encoding a group I intron encoded endonuclease recognition site selected from a group consisting of nucleotides of SEQ ID NO: 17, 19, 21, 23, 25, 27, 29, 35, 37, 39 41 and 43, wherein the nucleotide sequences is recognized by I-SceI, I-SceIV, I-SceII, I-CeuI, I-PpoI, I-SceIII, I-CreI, I-CsmI, I-PanI, I-TevI, I-Tev-II and I-TevIII endonucleases respectively, does not reasonably provide enablement for any recombinant mammalian chromosome that comprises any nucleic acid sequence (*other than the SEQ ID NO: 17, 19, 21, 23, 25, 27, 29, 35, 37, 39 41 and 43*) which is recognized by I-SceI, I-SceIV, I-SceII, I-CeuI, I-PpoI, I-SceIII, I-CreI, I-CsmI, I-PanI, I-TevI, I-Tev-II or I-TevIII endonucleases. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Nature Of Invention:

The invention as claimed relates to a recombinant chromosome and a cell comprising the chromosome wherein the chromosome comprises an endonuclease site selected from group I intron encoded endonuclease sites comprising I-SceI, I-SceIV, I-SceII, I-CeuI, I-PpoI, I-SceIII, I-CreI, I-CsmI, I-PanI, I-TevI, I-Tev-II and I-TevIII sites

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Breadth Of Claims And Guidance Provided By The Inventor:

The scope of invention as claimed encompasses a recombinant chromosome, wherein the exogenous transgene comprises a nucleotide sequences recognized by I-SceI, I-SceIV, I-SceII, I-CeuI, I-PpoI, I-SceIII, I-CreI, I-CsmI, I-PanI, I-TevI, I-Tev-II and I-TevIII endonucleases. At best the specification only disclosed that SEQ ID NO: 17, 19, 21, 23, 25, 27, 29, 35, 37, 39 41 and 43 which are the nucleotide sequences recognized by I-SceI, I-SceIV, I-SceII, I-CeuI, I-PpoI, I-SceIII, I-CreI, I-CsmI, I-PanI, I-TevI, I-Tev-II and I-TevIII endonucleases respectively. The instant specification fails to disclose any nucleic acid sequence (other than that SEQ ID NO: 17, 19, 21, 23, 25, 27, 29, 35, 37, 39 41 or 43) that is recognized by the I-SceI, I-SceIV, I-SceII, I-CeuI, I-PpoI, I-SceIII, I-CreI, I-CsmI, I-PanI, I-TevI, I-Tev-II or I-TevIII endonucleases respectively.

State Of Art And Predictability:

The stat of art regarding restriction endonucleases teaches that homing endonucleases are rare-cutting enzymes encoded by introns and inteins. They have striking structural and functional properties that distinguish them from restriction enzymes. Furthermore these enzymes make sites specific double-strand break that create recombinogenic ends, which engage in a gene conversion process that duplicates the intron or intein. Belfort et al, (Nucleic Acids Res. 25 (17): 3379-3388 1997; see abstract, page 3379, col.1-2). Furthermore, length and degeneracy for many of these sites remains to be determined (page 3382, table-3). On the other hand it is not certain that degeneracy would certainly lead to the endonuclease specificity. For example yeast maturase, which are intron encoded LAGLIDADG proteins are thought to be degenerate endonucleases, they often have no demonstrable DNA cleavage activity (page 3381 col.1). In instant case the applicant fails to disclose that any variation in the claimed I-SceI, I-SceIV, I-SceII, I-CeuI, I-PpoI, I-SceIII, I-CreI, I-CsmI, I-PanI, I-TevI, I-Tev-II or I-TevIII recognition sites that would impart the endonuclease specific recognition and/or cleavage activity.

Quantity Of Experimentation Required:

The scope of the claims must bear a reasonable correlation with the scope of enablement (In re Fisher, 166 USPQ 19 24 (CCPA 1970)). In instant case screening of any and all degenerate variants of endonuclease sites for I-SceI, I-SceIV, I-SceII, I-CeuI, I-PpoI, I-SceIII, I-CreI, I-CsmI, I-PanI, I-TevI, I-Tev-II or I-TevIII over the entire length of recognition sequences

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is not considered routine in the art. Making and testing a point mutation is significantly different from the making and testing changes over entire length of recognition sequences wherein any and all nucleic acid residues are added, deleted and/or substituted. The number of possible scenario increase geometrically with increase in percent non-identity. Such making and testing is nothing more than an invitation to further experimentation, since the specification can not be relied upon to teach how to make the variants as claimed. One has to engage in extensive making and testing in order to obtain variants that meet the requirements for the claimed I-SceI, I-SceIV, I-SceII, I-CeuI, I-PpoI, I-SceIII, I-CreI, I-CsmI, I-PanI, I-TevI, I-Tev-II or I-TevIII endonucleaase activity. This is not considered routine in the art and the experimentation left to those skilled in the art is unnecessarily, and improperly, extensive and undue. See In re Wands 858 F.2d 731, 8 USPQ2d 1400 (Fed. Cir, 1988). It is noted that the unpredictability of a particular area may alone provide reasonable doubt as to the accuracy of the broad statement made in support of enablement of claims. See Ex parte Singh, 17 USPQ2d 1714 (BPAI 1991). Therefore, one skill in the art would have to engage in excessive and undue amount of experimentation to exercise the invention as claimed.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sumesh Kaushal Ph.D. whose telephone number is 703-305-6838. The examiner can normally be reached on Mon-Fri. from 9AM-5PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yucel Irem Ph.D. can be reached on 703-305-1998. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-8724 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

S. Kaushal
PATENT EXAMINER

JEFFREY FREDMAN
PRIMARY EXAMINER

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REFERENCE COPYING

4/9/03

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- Belfort et al. Homing endonucleases: keeping the house in order Nucleic Acids Res. 1997 Sep 1;25(17):3379-88.